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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,957	07/26/2001	Moshe Milner	WBG-001	9944

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SCHNECK & SCHNECK  
P.O. BOX 2-E  
SAN JOSE, CA 95109-0005

EXAMINER

MARIAM, DANIEL G

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/868,957

**Applicant(s)**

MILNER ET AL.

**Examiner**

DANIEL G MARIAM

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The preliminary amendment filed on July 26, 2001 is objected to because the amendment indicates amendment pages to the specification that do not correspond to the pages, elements and/or paragraphs of the original specification, and the claims that are cancelled by the amendment, do not agree with the originally filed claims 1 through 4. The Examiner renumbered the claims for examination purposes only. Applicants should make corrections when responding to this Office Action.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 8-11 have been renumbered as 5-8. While applicants indicate to cancel claims 1-7 in the preliminary amendment, the number of claims filed originally is only four (claims 1-4).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ray, et al. (5,321,751).

With regard to claim 5, Ray, et al. discloses a method for verifying the identity of a credit card holder effecting a transaction (See for example, col. 1, lines 6-12), comprising:

introducing data and an image relating to each authorized credit card holder, i.e., authorized user and/or credit card holder, into a credit card company's, i.e., Card Administration Agency (CAA), data storage and communication unit or image display means, providing at least one credit card reader and a camera (these features reads on the single data reading device (20) shown in Fig. 1. What this means is that the reading device does obtain both the encoded information on the card and the photographic image of the card user which would later be transmitted or communicated to the CAA) at a purchasing location, i.e., point of sale location, for effecting communication with said data storage unit or image display means, operating said credit card reader and camera to effect display of the credit card holder's image and data on the company's image display means (See col. 4, lines 27 -51; and col. 5, lines 37-59); comparing the displayed image with the stored image of the card holder, and if the images are identical or similar and credit is approved, transmitting a signal, i.e., validation signal, to said purchasing location to complete the transaction (See col. 4, line 52 through col. 5, line 15; and col. 5, lines 37-59).

With regard to claim 6, the method as claimed in claim 8, wherein said camera is operated to photograph the credit card holder and to communicate the picture to said data storage unit or image display means (See for example, col. 4, lines 27-39).

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With regard to claim 7, the method as claimed in claim 8, wherein said camera is operated to photograph the image of the credit card holder embedded in the credit card and to communicate the picture to said data storage unit or image display means (See col. 4, lines 27-39; and Figure 2).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Houvener, et al. (6,040,783).

With regard to claim 8, Houvener, et al. discloses a method enabling credit companies to monitor and verify credit card holder identity when a payment transaction is performed at a sales terminal, i.e., point of sale terminal (See for example, col. 3, lines 9-32; and col. 4, lines 32-44), said method comprising: displaying multiple images of identification data, at least one of which is true; prompting the payment terminal operator, i.e., store clerk, to select the correct data, determining whether the selected data is correct, and either completing or denying the transaction (See for example, col. 7, lines 14-22; and col. 12, lines 25-41).

### ***Conclusion***

7. The prior art made of record and not relied upon disclose identical invention as applicants' claimed invention. US Patent Numbers: 4821118, 4993068, 5432864, 5826245,

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6270011, and 6202055; PCT WO9606409A1; and an IBM Technical Disclosure "Facial Image Data on Credit Card for Identification".

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G MARIAM whose telephone number is 703-305-4010. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LEO BOUDREAU can be reached on 703-305-4607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DANIEL MIRIAM**  
**PRIMARY EXAMINER**

July 15, 2004